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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,040	10/03/2000	Jeffrey Marsden	50538.2USPT	5664

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/678,040

Applicant(s)

MARSDEN ET AL.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Summary**

On June 9, 2004, an Office Action was sent to the Applicant rejecting claims 1-11. On November 8, 2004, the Applicant responded by canceling claims 1-11 and adding new claims 12-37.

### ***Drawings***

The objection has been withdrawn.

### ***Specification***

The objection has been withdrawn.

### ***Claim Rejections - 35 USC § 112***

The rejection has been withdrawn.

### ***Claim Rejections - 35 USC § 101***

The rejection has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12, 15-19, and 29-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Gatto (6,681,211).

Gatto discloses a security analyst estimate performance viewing system comprising a comparative price performance framework for allowing comparison of price performance among a plurality of brokers over a given time period, a first set of data linking the broker with a plurality of clients, including transactions performed by the broker for each client during the time period, and the price charged by the broker for each said transaction (client can pull up any amount of information), second set of data comprising each broker's experience and transaction volume, a software means in communication with the database for sorting the brokers and their respective first sets of data into a plurality of peer groups, the peer groups being based on pre-determined ranges of broker experience and transaction volume, as determined from each broker's second set of data, and an interface in communication with the software means for displaying, for a selected broker: price statistics for the broker's transactions during the time period, and comparative price statistics for the transactions of brokers within the same peer group as the selected broker (col.3, line 1 to col.5, line 32); the price statistics and the comparative price statistics comprise at least one statistic from the group consisting of: total revenues, average price per transaction, price realization ratio, and price to principal ratio (col.3, line 1 to col.5, line 32); the brokers comprise securities brokers (col.3, line 1 to col.5, line 32); the interface is further capable of displaying, for a selected peer group and selected price statistic, a rank list of brokers within that peer group ordered according to said selected price statistic (col.3, line 1 to col.5, line 32); the database further comprises at least one target value for a price statistic and the interface is further capable of displaying one or more actual values of a selected price

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statistic concurrently with the target value for the selected price statistic to permit comparison (col.3, line 1 to col.5, line 32); the target value is linked to a broker in the database (col.3, line 1 to col.5, line 32); a set of data linking the broker with a plurality of transactions performed by the broker during the time period, type of each said transaction, principal value of each said transaction, and price charged by the broker for each said transaction, and a software means in communication with the database for sorting the transactions for each broker into pre-determined transaction groups based on one or both of the following criteria: the type of the transaction and the principal value of the transaction, an interface in communication with the software means for displaying, for a selected broker: price statistics for the broker's transactions during the time period sorted by transaction group, and comparative price statistics during the time period of other brokers sorted by transaction group (col.3, line 1 to col.5, line 32); the price statistics and the comparative price statistics comprise at least one statistic from the group consisting of: total revenues, average price per transaction price realization ratio, and price to principal ratio (col.3, line 1 to col.5, line 32); the brokers comprise securities brokers (col.3, line 1 to col.5, line 32); the database comprises one or more firms of brokers (col.3, line 1 to col.5, line 32); the interface is further capable of displaying, for a selected broker, comparative price statistics for the transactions of brokers within the same firm as the selected broker (col.3, line 1 to col.5, line 32); interface is further capable of displaying, for a selected firm and selected price statistic, a rank list of brokers within the selected firm ordered according to said selected price statistic (col.3, line 1 to col.5, line 32); the database further comprises at least one

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target value for a price statistic and the interface is further capable of displaying one or more actual values of a selected price statistic concurrently with the target value for the selected price statistic to permit comparison (col.3, line 1 to col.5, line 32); framework of claim 35, wherein the target value is linked to a broker in the database (col.3, line 1 to col.5, line 32); and the target value is linked to a firm in the database (col.3, line 1 to col.5, line 32).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13-14 and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto in view of Giansante (6,275,814).

Gatto discloses the invention substantially as claimed; however, Gatto does not disclose client attractiveness value (CAV) groups. Giansante teaches an investment portfolio system and method comprising what the Examiner is interpreting as being a

CAV (col.5, lines 1-30—ranking based on total assets in each investment account or portfolio). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include CAV, as substantially taught by Giansante into the invention disclosed by Gatto, to allow the user to have another piece of information to aide them in their investment decision when researching brokers.

### ***Response to Arguments***

Applicant's arguments filed November 8, 2004 have been fully considered but they are not persuasive. With regard to the amendment, Gatto reads onto the invention substantially as claimed in that Gatto discloses a system that allows for comparison of price performance amongst a plurality of brokers over a given time period. Giansante teaches an investment portfolio and selection system and has been incorporated as a teaching of CAV groups. Giansante was not incorporated as a teaching of discretionary pricing transactions.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

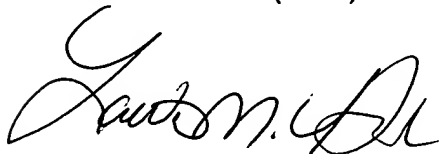
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LMH

VINCENT MILLIN  
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